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09/718,071	11/21/2000	Jay C. Hsu	KCX-359 (15169)	1979

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Jason W. Johnston,  
Dority & Manning, P.A.  
PO Box 1449  
Greenville, SC 29602-1449

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
1619	5

DATE MAILED: 01/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/718,071	HSU ET AL.	
	<b>Examiner</b> Lauren Q Wells	<b>Art Unit</b> 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-43 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-43 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

Claims 1-43 are pending.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 11, 13, 14-23, 26-36, 38-41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6, 8, 10-12, 14-17, 27-31, 34, 36, 38-40, 42 and 43-44 of copending Application No. 09717939. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed toward paper products comprising a paper web and a water soluble lotion composition. It is noted that emulsifiers, emollients and fatty alcohols are known in the art to impart viscosity modification and skin conditioning properties to compositions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The phrase "add-on level" in claim 1 (line 5), claim 18 (lines 1-2), claim 19 (lines 1-2), claim 22 (line 6), claim 29 (lines 1-2), claim 30 (line 6), claim 41 (line 1), claim 42 (line 1) is vague and indefinite, as it is not clear what an add-on level of a paper web is. The specification does not define this phrase and one of ordinary skill in the art would not be apprised of such a phrase.

(ii) It has been held that the recitation that an element is "capable of" (claim 1 (line 14), claim 22 (line 17), claim 30 (line 15)) performing a function is not a positive limitation but only requires the ability to so perform that function. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ.

(iii) The term "water soluble" in claims 1, 3, -5, 7, 9, 22-25, 30, 34-35 is a relative term which renders the claim indefinite. The term "water soluble" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. How soluble in water or how insoluble in water is the phrase "water soluble"?

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(iv) The phrase "amount up to" in claims 1 (lines 8, 10, 12), 5 (line 2), 14 (line 2) is vague and indefinite, as it is not clear whether this phrase includes the amount of zero thereby removing the requirement of certain constituents from the composition.

(v) The term "viscosity modifier" in claims 1, 11, 12, 22, 30, 36, and 37 is a relative term which renders the claim indefinite. The term "viscosity modifier" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Does the phrase encompass agents that both increase and decrease viscosity? Although the specification discloses that viscosity modifiers can include surfactants, the specification does not further define this phrase.

(vi) The phrases "including" and "includes" in claims 1 (line 13), 4 (line 2), 9 (line 2), 12 (line 2), claim 22 (lines 13, 17), 23 (line 2), 24 (line 2), 25 (line 2), 30 (line 14), 35 (line 2), 37 (line 2) is vague and indefinite, as it is not clear what else is included in these claims.

(vii) The phrase "liquid coupling component" in claims 1, 13, 22, 30, 38 is vague and indefinite, as it is not clear what chemical compounds/components this phrase encompasses. The term "liquid coupling agent" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

(viii) The phrase "through drying" in claim 30 (line 4) is vague and indefinite as it is not clear what type of drying method this phrase encompasses. Does it mean drying from the inside out? Does it mean thoroughly dry? Does it mean something else?

***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Lorenzi et al.

(2001/0018068).

Lorenzi et al. teach personal care articles comprising a creped nonwoven layer and a cleansing component disposed adjacent to the nonwoven layer, wherein the cleansing component comprises 10-100% of the nonwoven layer. Disclosed is a composition comprising 25-30% glycerin, 8% water and 7.5% aluminum/magnesium hydroxystearate in mineral oil (coupling agent). PEG 2000 is disclosed as a surfactant for use in the hydrophilic phase of the composition and sorbitol is disclosed as an active skin care ingredient in the composition. Antimicrobial agents are disclosed as additional ingredients. See [0023]-[0213]; [0277]-pg. 44.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatt et al. (5,593,508) in view of Lorenzi et al. (2001/0018068) or Luu et al. (5,871,763) or Roe et al. (6,120,783) and Hersch et al. (5,661,119) or Cauwet et al. (5,756,079) in further view of Phan et al. (WO 93/21383) and Vlasblom (WO 99/41068).

Gatt et al. teach moist, absorbent materials for cleaning articles and surfaces. It is disclosed that moist towelettes comprising water, propylene glycol, PEG 75, lanolin, cocoamphodiacetate, polysorbate 20, methylparaben, propylparaben, and 2-bromo-2-nitropropene 1,3-diol are known. It is further disclosed that similar products based on a combination of water, propylene glycol and surfactants are known. The reference fails to teach percent weights, coupling agents, and methods of making the paper product. See Col. 1, line 1-Col. 4, line 21.

Lorenzi et al. is disclosed as discussed above.

Luu et al. teach a substrate treated with lotion, wherein the lotion comprises an aromatic ester or fatty alcohol ester of a non-fatty organic acid emollient or a mixture thereof and a retention/release agent, and optionally, surfactant, and/or medicinal gent. The substrate is disclosed as a tissue, towel or napkin. The lotion is disclosed as comprising about 15% or less of water. Polyethylene glycol of 900 molecular weight or higher is disclosed as the retention/release agent comprising 25-95% of the composition. Antimicrobial agents are disclosed as medicinal agents. The lotion is disclosed as comprising 0.1-25% of the substrate. See Col. 2, line 54-Col. 10, line 18; Col. 12, line 61-Col. 14, line 17; Col. 18, line 62-Col. 22, line 60.

Roe et al. teach web materials with two or more skin compositions disposed thereon and articles made therefrom. The composition is disclosed as comprising 0.1-25% of the substrate.

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The composition is disclosed to be in the form of a lotion. Skin protectants or emollients are disclosed as useful active ingredients. Propylene glycol and glycerine are disclosed as emollients and glycerine, propylene glycol and sorbitol are disclosed as humectants. The composition can comprise from 0-100% emollient. Compounds capable of immobilizing the composition (viscosity modifiers) are disclosed as optional components of the composition comprising from 5-90% of the composition. Antibacterial actives and preservatives are disclosed as additional components for use in the composition. Water-based skin care compositions are disclosed which comprise preservatives and viscosity increasing agents. It is further disclosed that immobilizing agents may require an emulsifier for solubilization in the emollient. Hydrophilic compositions are further disclosed as comprising hydrophilic surfactants to improve wettability of the composition. Col. 5, line 21-Col. 7, line 63; Col. 26, line 63-Col. 43, line 35.

Hersh et al. teach skin cleansing formulations with terpene solvents and corn meal scrubber. Disclosed is a composition comprising water, propylene glycol, peg-75 lanolin, nonoxynol-6 and nonoxynol-9. Hexylene glycol and polyoxypropylene polyoxyethylene glyceryl ether are disclosed as coupling agents that are used to stabilize the emulsion. Col. 1, line 45-Col. 10, line 65.

Cauwet et al. teach cosmetic composition containing at least one anionic surfactant of alkylgalactoside uronate type and at least one nonionic surfactant of alkylpolyglycoside and/or polyglycerolated type. Disclosed is a composition comprising water, tallow ether of myristil glycol, glycerol, and sodium decyl d-galactoside uronate (coupling agent), wherein the uronate comprises between 5 and 60% of the composition. Col. 6, line 42-Col. 12, line 29.

Phan et al. teach tissue paper webs useful in the manufacture of soft, absorbent products such as napkins, facial tissues and sanitary tissues, and processes for making the webs. A process is disclosed wherein there are three steps. The first step comprises forming an aqueous papermaking furnish, the second and third steps comprise the deposition of the papermaking furnish onto a foraminous surface and removal of the water from the deposited furnish. See pg. 17, line 27-pg. 30.

Vlasblom teaches cleaner impregnated towels. A method of making the cleaner towels is disclosed wherein the substrate (towel) is sprayed with the cleaner formulation or conveyed through a wetting vat of the cleaner formulation. See pg. 9, line 10-pg. 19.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention described by Gatt et al. using the teachings of Lorenzi or Luu et al. or Roe et al. and obtain an absorbent paper product comprising a paper web and a water soluble lotion composition of the preferred percent weights of the instant invention because a) Gatt, Lorenze, Luu, and Roe all teach absorbent paper products comprising paper webs and water-soluble lotion compositions for use as a cosmetic/cleanser; b) Gatt, Lorenzi and Roe all teach water-soluble lotion compositions comprising propylene glycol, water, skin conditioner (emollient), surfactant, and antimicrobial/preservative. Furthermore, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It is also well-established that merely selecting proportions and ranges is not patentable absent a showing of criticality. In re Becket, 33 USPQ 33 (CCPA 1937). In re Russell, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of the combined references by adding the coupling agents of Hersch or Cauwet and obtain a paper product wherein the lotion composition comprises a coupling agent because a) the combined references, Hersch and Cauwet all teach cosmetic compositions comprising water, skin conditioning agent, and surfactant; b) Hersch and the combined references teach compositions comprising water, propylene glycol, peg-75 lanolin and antimicrobial agent; c) Hersch teaches coupling agents as stabilizing the emulsification of hydrophobic components of a composition.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Phan et al. and Vlasblom to make the paper products of the combined references because a) all three references teach paper products impregnated with cosmetic benefit agents; b) Phan et al. teach the method of making tissue paper webs as conventional in the papermaking art; c) Vlasblom and the combined references all teach the cleansing article as being adjacent (on top) to the nonwoven layer; d) the combined references teach that their articles can be made via any conventional method of making paper, such as sprinkling, simple extrusion, dip coating, spraying, slot coating, roll transfer, gravure printing and a dipping and nipping application.

The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references. Therefore, the claims are properly rejected under 35 U.S.C. § 103.

***Prior Art***

The prior art made of record and not specifically relied upon in any rejections cited above is either 1) considered cumulative to the prior art that was cited in a rejection or is 2) considered pertinent to the applicant's disclosure and shows the state of the art in its field but is not

determined by the Examiner to read upon the invention currently being prosecuted in this application.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
November 20, 2001



DAMERON L. JONES  
PRIMARY EXAMINER